

raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-570.)

§ 318. Stay of litigation

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

(Added Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-570.)

PART IV—PATENT COOPERATION TREATY

Chap.		Sec.
35.	Definitions	351
36.	International Stage	361
37.	National Stage	371

CODIFICATION

Analysis of chapters editorially supplied. Part IV added by Pub. L. 94-131 without adding analysis for chapters 35, 36, and 37.

Pub. L. 96-517 purported to amend the table of chapters of title 35 by adding after the item for chapter 37 the following: “38. Patent Rights in Inventions Made with Federal Assistance”. Title 35 did not contain a table of chapters, and section 6(b) of Pub. L. 96-517 and the purported amendment made by it were repealed by Pub. L. 97-256. See chapter 18 (§200 et seq.) of this title.

CHAPTER 35—DEFINITIONS

Sec.	
351.	Definitions.

§ 351. Definitions

When used in this part unless the context otherwise indicates—

(a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term “Regulations”, when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations”, when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of

whether or not the United States has been designated in that international application.

(e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term “International Bureau” means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

(Added Pub. L. 94-131, §1, Nov. 14, 1975, 89 Stat. 685; amended Pub. L. 98-622, title IV, §403(a), Nov. 8, 1984, 98 Stat. 3392; Pub. L. 99-616, §2(a)-(c), Nov. 6, 1986, 100 Stat. 3485; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

AMENDMENTS

1999—Subsec. (b). Pub. L. 106-113 substituted “Director” for “Commissioner”.

1986—Subsec. (a). Pub. L. 99-616, §2(a), struck out “, excluding chapter II thereof” after “June 19, 1970”.

Subsec. (b). Pub. L. 99-616, §2(b), struck out “excluding part C thereof” after “under the treaty”.

Subsec. (g). Pub. L. 99-616, §2(c), substituted “The terms ‘International Searching Authority’ and ‘International Preliminary Examining Authority’ mean” for “The term ‘International Searching Authority’ means”.

1984—Subsec. (d). Pub. L. 98-622 substituted “Patent and Trademark Office” for “Patent Office”.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1986 AMENDMENT

Section 9 of Pub. L. 99-616 provided that: “Sections 2 through 8 of this Act [amending this section and sections 361, 362, 364, 368, 371, and 376 of this title] shall come into force on the same day as the effective date of entry into force of chapter II of the Patent Cooperation Treaty with respect to the United States, by virtue of the withdrawal of the declaration under article 64(1)(a) of the Patent Cooperation Treaty. It shall apply to all international applications pending before or after its effective date.”

[The Patent Cooperation Treaty became effective for the United States on Jan. 24, 1978. The United States, however, was one of six countries (out of the 40 countries who have ratified or acceded to the Treaty) which had reservations not to be bound by Chapter II. The document removing the reservation as to Chapter II was deposited with the Director General of the World

Intellectual Property Organization on Apr. 1, 1987. Accordingly, Chapter II of the Treaty for the United States of America and Pub. L. 99-616 became effective 3 months later on July 1, 1987. See 52 F.R. 20038, 20041, May 28, 1987.]

EFFECTIVE DATE OF 1984 AMENDMENT

Section 406(a) of Pub. L. 98-622 provided that: “Section 404 of this Act [set out as a note under section 41 of this title] and the amendments made by section 403 of this Act [amending this section and sections 104, 361, 362, 363, 364, 365, 367, 368, 371, 372, 373, and 376 of this title] shall take effect on the date of the enactment of this Act [Nov. 8, 1984].”

EFFECTIVE DATE

Section 11 of Pub. L. 94-131 provided that:

“(a) Section 1 of this Act [enacting this part] shall come into force on the same day as the entry into force of the Patent Cooperation Treaty with respect to the United States. It shall apply to international and national applications filed on and after this effective date, even though entitled to the benefit of an earlier filing date, and to patents issued on such applications.

“(b) Sections 2 to 10 of this Act [amending sections 6, 41, 42, 102, 104, 112, 113, 120, and 282 of this title] shall take effect on the same day as section 1 of this Act [enacting this part] and shall apply to all applications for patent actually filed in the United States on and after this effective date, as well as to international applications where applicable.

“(c) Applications for patent on file in the Patent Office [now the Patent and Trademark Office] on the effective date of this Act, and patents issued on such applications, shall be governed by the provisions of title 35, United States Code, in effect immediately prior to the effective date of this Act.”

[The Patent Cooperation Treaty entered into force with respect to the United States on Jan. 24, 1978, with the exception of Chapter II.]

SHORT TITLE OF 1986 AMENDMENT

Section 1 of Pub. L. 99-616 provided: “That this Act [amending this section and sections 361, 362, 364, 368, 371, and 376 of this title and enacting provisions set out as a note above] may be cited as the ‘Act to authorize the United States to participate in chapter II of the Patent Cooperation Treaty’.”

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 102, 154, 374 of this title.

CHAPTER 36—INTERNATIONAL STAGE

- | | |
|------|--|
| Sec. | |
| 361. | Receiving Office. |
| 362. | International Searching Authority and International Preliminary Examining Authority. |
| 363. | International application designating the United States: Effect. |
| 364. | International stage: Procedure. |
| 365. | Right of priority; benefit of the filing date of a prior application. |
| 366. | Withdrawn international application. |
| 367. | Actions of other authorities: Review. |
| 368. | Secrecy of certain inventions; filing international applications in foreign countries. |

AMENDMENTS

1986—Pub. L. 99-616, §3, Nov. 6, 1986, 100 Stat. 3485, amended item 362 generally.

§ 361. Receiving Office

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agree-

ment made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within such later time as may be fixed by the Director.

(Added Pub. L. 94-131, §1, Nov. 14, 1975, 89 Stat. 686; amended Pub. L. 98-622, title IV, §§401(a), 403(a), Nov. 8, 1984, 98 Stat. 3391, 3392; Pub. L. 99-616, §2(d), Nov. 6, 1986, 100 Stat. 3485; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

AMENDMENTS

1999—Subsec. (d). Pub. L. 106-113 substituted “Director” for “Commissioner”.

1986—Subsec. (d). Pub. L. 99-616 amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: “The basic fee portion of the international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall be paid on filing of an international application or within one month after the date of such filing. Payment of designation fees may be made on filing and shall be made not later than one year from the priority date of the international application.”

1984—Subsecs. (a) to (c). Pub. L. 98-622, §403(a), substituted “Patent and Trademark Office” for “Patent Office”.

Subsec. (d). Pub. L. 98-622, §401(a), inserted “or within one month after the date of such filing” after “application”.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1986 AMENDMENT

Amendment by Pub. L. 99-616 effective July 1, 1987, and applicable to all international applications pending before or after that date, see section 9 of Pub. L. 99-616, set out as a note under section 351 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by section 401(a) of Pub. L. 98-622 effective six months after Nov. 8, 1984, see section 406(b) of Pub. L. 98-622, set out as a note under section 3 of this title.

Amendment by section 403(a) of Pub. L. 98-622 effective Nov. 8, 1984, see section 406(a) of Pub. L. 98-622, set out as a note under section 351 of this title.

EFFECTIVE DATE

Chapter effective Jan. 24, 1978, and applicable to international and national applications filed on and after that date, see section 11 of Pub. L. 94-131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 376 of this title.